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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,992	12/05/2001	Ritsuko Tanaka	1086.1152	2820

21171 7590 06/08/2005

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EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/001,992

Applicant(s)

TANAKA ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed March 7, 2005. Applicant amended claims 1, 2, 18-22, added claim 23. Claims 1-23 are currently pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (US 5,740,549) further in view of NAA @ Presstime: NEXPO'97 Report, <http://www.naa.org/presstime/97nexpo/nexad.html> (hereinafter NEXPO'97).

Regarding claims 1-4, Reilly teaches a database, which registers a supplier for providing a first service (access to a newspaper) and users that have contract with the supplier (publisher) (see col. 7 lines 45-54); and advertisement preparation unit for placing the advertisement on a web page; allowing the user to view the advertisement on the web page (see col. 8 line 45 to col. 9 line 17 col. 13 line 29 to col. 14 line 16). Reilly does not teach preparation unit for preparing an advertisement requested by an advertiser. NEXPO'97 teaches advertisement preparation unit for preparing and placing advertisement requested by an advertiser; putting an electronic medium advertisement from advertisers, converting it to an electronic data and placing it on a web page, (see pp 1-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reilly's on-line news with NEXPO'97's advertisement publishing or

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preparation method/system, since the feature provides advertisers control of the preparation and administration of their advertisement.

Regarding claims 5-13, Reilly teaches giving a privilege offered by a newspaper dealer or an advertiser to user viewing the advertisement, storing advertisement selection information specified by the user and delivering such advertisement, providing link to an advertiser; editing a Web page based upon advertisement selected by the user; placing local information other than advertisement; providing an application page for subscribing to the newspaper; etc., (see col. 5 line 45 to col. 6 line 67, col. 7 lines 13-65, col. 9 lines 10-32, col. 13 line 28 to col. 15 line 6).

Regarding claims 14, 15, Reilly does not teach preparation of a guide map upon a request from the user. Official Notice is taken that is old and well known in the art of WWW to provide a preparation of a guide map and to display it. On-line advertisers provide a program such as Mapquest to provide a map of a location, including the current location of the user and the destination specified by the user, in order to find the geographical location of the advertiser. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such feature, in Reilly web page since Internet users use on-line map, such as Mapquest, to find the location of the advertiser providing the advertisement. Reilly teaches providing a link to advertiser's web page (see col. 13 line 65 to col. 14 line 11. It is also well known to providing an order request after user access advertisers web page and delivering the ordered product. Therefore, It would have been obvious to provide such feature in Reilly's access to the advertiser's web page in order to make a purchase from the advertiser.

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Regarding claim 16, Reilly does not teach printing the advertisement, however it is well known to print an ad from a web page. Therefore, it would have been obvious at the time of the invention for client to print the displayed ad such as coupon, in order to redeem the coupon.

Regarding claim 17, Reilly teaches collecting display statistics indicating how many times the ad was viewed, etc. Reilly failed to teach determining and settling publishing fee based upon the statistics. It is well known to charge advertisers based on flat fee, or ad viewed or click-through of ads. It would have been obvious to one of ordinary skill in the art at the time of the invention to charge advertisers based on the display count or click-through or flat rate, since various methods are use to rate different advertising media on the basis of their ability to attract viewers with desired demographic information.

Claims 18-23 are rejected as stated above in claim 1.

### ***Response to Arguments***

Applicant's arguments, filed March 7, 2005, with respect to the rejection(s) of claim(s) 1-22 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Reilly (US 5,740,549) further in view of NAA @ Presstime: NEXPO'97 Report, <http://www.naa.org/presstime/97nexpo/nexad.html>.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pasqual (US 6272493 B1) teaches subscribers to online newspaper or publication and viewing advertisement.

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Flavin et al. (US 6219788) teaches advertisement appearing in on-line newspaper and subscriber viewing the ads.

Naimpally (US 6130720) teaches subscriber having access to local information such as movie theater listings, newspaper articles, weather forecasts, advertising, stage productions, local television station and cable station programming information, and the like.

Dozier et al. (US 5870552) teaches allowing network users to take advantage of interactive on-line services such as subscribing to a publication, registering for a conference, or perhaps even more exotic applications like participating in multi-player games contests.

Ferguson et al. (US 5819092) teaches online service that selects specific items from a collection of newsfeeds, based on a user's previously registered interests, and assembles a customized electronic newspaper and metering of user usage patterns for the online service, used to levy fees for users, advertisers, or information providers, or to tune the service itself.

Stumm (US 5768528) teaches providing on-line publications to a plurality of subscribers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta  
Primary Examiner  
Art Unit 3622

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